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EXAMINER

CUTLER, ALBERT H

ART UNIT

PAPER NUMBER

2622

NOTIFICATION DATE

DELIVERY MODE

03/17/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/699,774 | Applicant(s) SUEHIRO, MASAKO | |
| | Examiner ALBERT H. CUTLER | Art Unit 2622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 is/are allowed.
- 6) ☒ Claim(s) 8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is responsive to communication filed on January 5, 2009.

Claim Objections

2. Claims 8 and 10 are objected to because of the following informalities: Lack of clarity and precision.

Claim 8 recites “to send images to the image sending **device**”. However, no “image sending device” has previously been defined in claim 8. Upon further examination, the Examiner has determined that claim 8 should read “to send images to the image sending **apparatus**”. Appropriate correction is required.

Claim 8 recites “control a switch between the first communication mode and the second communication”. Upon further examination, the Examiner has determined that claim 10 should read “control a switch between the first communication mode and the second communication **mode**”. Appropriate correction is required.

Claim 10 recites “enabling the image sending **device**”. However, no “image sending device” has previously been defined in claim 10. Upon further examination, the Examiner has determined that claim 10 should read “enabling the image sending **apparatus**”. Appropriate correction is required.

Claim 10 recites “a transfer instruction device which sends a first instruction to **an** external device”. However, an “external device” has already been defined. Upon further examination, the Examiner has determined that claim 10 should read “a transfer instruction device which sends a first instruction to **the** external device”. Appropriate correction is required.

3. The Examiner indicated that claims 8 and 10 were allowable in the office action mailed October 7, 2008. However, upon further consideration, the indicated allowability of claims 8 and 10 is withdrawn in view of the newly discovered reference(s) to Skarbo et al. (US 5,778,053). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Skarbo et al. (US 5,778,053).

Consider claim 8, Skarbo et al. teaches:

An image receiving apparatus (Skarbo et al. teaches of a plurality of computers (110, 120, 130, figure 1) connected for video conferencing, column 3, lines 7-17 and lines 47-54. The computers contain answering machine functionality (column 4, lines 20-27) and figure 13 shows the data flow between two of the computers and respective answering machines (“AM”). The Examiner interprets the “Callee AM” of figure 13 to be the image receiving apparatus.), comprising:

a communication device (The individual computers (110, 120, 130) are connected to a medium (101, figure 1) used for communication, column 3, lines 13-34.) which has

a first communication mode for, on receiving an image capturing command from an image sending apparatus (i.e. "Caller AM", figure 13), capturing in the image receiving apparatus (i.e. "Callee AM", figure 13) an image selected and sent by the image sending apparatus (See figure 13. The image sending apparatus ("Caller AM") sends an image capturing command ("Send Message (Answer Message Start A/V)"), and then the image receiving apparatus ("Callee AM") captures an A/V stream (i.e. a plurality of selected images, see "Start Stream Record" and "Stop Stream Record"). See column 6, line 41 through column 7, line 11.), and

has a second communication mode enabling the image receiving apparatus ("Callee AM") to send images to the image sending apparatus ("Caller AM") for storage therein (See "Send Stream (Greeting from .AVI file)", figure 13, figure 4, column 6, lines 41-58. The image receiving apparatus ("Callee AM") sends a greeting comprised of images to the image sending apparatus ("Caller AM") for recording and display in a second communication mode.);

a recording device (memory, 117) which records the image selected and sent by the image sending apparatus through the communication device (Messages comprising a plurality of images sent by the caller are recorded in the callee's AM, column 7, lines 10-11.); and

a mode switch control device which sends an order to the image sending apparatus to control a switch between the first communication mode and the second communication mode (See figure 13. The callee AM sends an order ("Send Message (Greeting Over)") which controls a switch from the second communication mode in which a greeting is sent from the callee to the caller to the first communication mode in which selected A/V images are stored in the "Callee AM". See figure 4, column 6, lines 41-50.), wherein

on checking that there has been a transfer instruction received from the image sending apparatus through the communication device (The Examiner interprets ("Send Message (Ready for Greeting)") of figure 13 to be the transfer instruction sent by the image sending apparatus.), the mode switch control device determines whether or not the communication mode with the image sending apparatus is the first communication mode (i.e. whether the greeting streamed in the second communication mode is done being sent and thus the first communication mode has begun), and sends a conversion command ordering change to the first communication mode if determined that a current communication mode of the image sending apparatus is not the first communication mode (Upon the greeting being sent ("Send Stream (Greetings from .AVI file)"), a conversion command ("Send Message (Greeting Over)") is sent to change to the first communication mode. See also figure 4, column 6, lines 41-50.).

Consider claim 10, Skarbo et al. teaches:

An image sending apparatus (Skarbo et al. teaches of a plurality of computers (110, 120, 130, figure 1) connected for video conferencing, column 3, lines 7-17 and lines 47-54. The computers contain answering machine functionality (column 4, lines 20-27) and figure 13 shows the data flow between two of the computers and respective answering machines ("AM"). The Examiner interprets the "Caller AM" of figure 13 to be the image sending apparatus.), comprising:

an image capturing device which captures an image (see "video camera", 111, figure 1, column 3, lines 11-13);

a first communication device (The individual computers (110, 120, 130) are connected to a medium (101, figure 1) used for communication, column 3, lines 13-34.) which has

a first communication mode for sending an image selected by the image sending apparatus to an external device (See figure 13. The image sending apparatus ("Caller AM") sends an image capturing command ("Send Message (Answer Message Start A/V)", and then an image receiving apparatus (i.e. external device, "Callee AM") captures an A/V stream (i.e. a plurality of selected images, see "Start Stream Record" and "Stop Stream Record") from the image sending apparatus. See column 6, line 41 through column 7, line 11.), and

a second communication mode for enabling the image sending apparatus to function as an external recording device for the external device (See "Send Stream (Greeting from .AVI file)", figure 13, figure 4, column 6, lines 41-58. The image

receiving apparatus (i.e. external device, "Callee AM") sends a greeting comprised of images to the image sending apparatus ("Caller AM") for recording and display in a second communication mode.);

a transfer instruction device which sends a first instruction to the external device for instructing the external device to receive an image sent from the image sending apparatus (See figure 13. The image sending apparatus ("Caller AM") sends an image capturing command (i.e. first instruction) "Send Message (Answer Message Start A/V)" to the external device ("Callee AM").); and

an automatic mode switching device which automatically switches at least to the first communication mode from the second communication mode in the first communication device (See figure 13. The callee AM sends an order ("Send Message (Greeting Over)") which controls a switch from the second communication mode in which a greeting is sent from the callee to the caller to the first communication mode in which selected A/V images are stored in the "Callee AM". See figure 4, column 6, lines 41-50.) upon receipt of a second instruction from the external device ordering the image sending apparatus to switch to the first communication mode from the second communication mode (Figure 13 details that upon the greeting being sent ("Send Stream (Greetings from .AVI file)") in the second communication mode, a second instruction ("Send Message (Greeting Over)") is sent to change to the first communication mode. See also figure 4, column 6, lines 41-50.), wherein

the second instruction is sent from the external device when the first communication device sends the first instruction (See figure 13. The second instruction

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("Send Message (Greeting Over)") and first instruction ("Send Message (Answer Message Start A/V)") are consecutive steps and thus the Examiner interprets the second instruction to be sent when the first instruction is sent.).

Allowable Subject Matter

6. Claims 1-6 are allowed.
7. The following is a statement of reasons for the indication of allowable subject matter:

Consider **claim 1**, the prior art of record teaches an image sending and receiving system, comprising an image sending apparatus which comprises an image capturing device which captures an image, a recording device which records the captured image on a recording medium, an image selecting device which selects a desired image of images recorded on the recording medium, a first communication device which has a first communication mode capable of sending an image capturing command to an external device and sending the image selected by the image selecting device to the external device, and a second communication mode for enabling the image sending device to function as an external recording device for the external device, a transfer instruction device which outputs a transfer instruction for transferring the image selected by the image selecting device to the external device through the first communication device, and an automatic mode switching device which automatically switches between the first communication mode and the second communication mode in the first communication device upon receipt of an order from the external device, and the

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external device includes an image receiving apparatus which comprises, a second communication device which performs at least communication in the first communication mode with the image sending apparatus, a recording device which records the image received through the second communication device, and a mode switch control device which orders the image sending apparatus to control a switch between the first communication modes mode and the second communication mode of the image sending apparatus, wherein, the mode switch control device of the image receiving apparatus determines whether or not the communication mode with the image sending apparatus is the first communication mode, and sends a conversion command ordering change to the first communication mode if determined that a current communication mode of the image sending apparatus is not the first communication mode, and on receiving the conversion command from the image receiving apparatus, the automatic mode switching device of the image sending apparatus switches the communication mode of the first communication device to the first communication mode.

However, the prior art of record does not teach nor reasonably suggest that the mode switch control device of the image receiving apparatus controls the mode of the image sending apparatus based on checking that there has been the transfer instruction of the image selected by the image selecting device from the transfer instruction device of the image sending apparatus as recited in claim 1.

Claims 2-6 are allowed as depending from an allowed claim 1.

Conclusion

8. Any objections previously made to the claims by the Examiner are hereby withdrawn in view of Applicant's response.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALBERT H. CUTLER whose telephone number is (571)270-1460. The examiner can normally be reached on Mon-Thu (9:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tuan V Ho/
Primary Examiner, Art Unit 2622

AC